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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,930	01/16/2004	Kulvir Singh Bhogal	AUS920030586US1	8211

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EXAMINER

RIES, LAURIE ANNE

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/759,930		BHOGAL ET AL.	
	Examiner		Art Unit	
	Laurie Ries		2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/29/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 3-4, 14-15, 17, 20, 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding dependent claims 3, 14, and 23, it is unclear as to the resulting action should the user select the option that said bibliographical information should **not** be inserted within the bibliographical section.

Regarding dependent claim 20, a claim to a system, is listed as dependent upon claim 1, a method claim. For the purpose of further examination it is assumed that claim 20 should be dependent upon claim 12.

Regarding dependent claim 24, this claim is listed as being dependent upon itself. For the purpose of further examination it is assumed that claim 24 should be dependent upon claim 23.

Dependent claims 4, 15, and 17 are rejected for fully incorporating the deficiencies of the claims from which they depend.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding independent claims 11 and 21, the language of these claims merely describes a computer program per se. As such, this raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine, which would result in a practical application producing a concrete, useful and tangible result to form the basis of statutory subject matter under 35 USC 101.

One technique for satisfying the requirements of 35 USC 101 is to claim code residing in memory (i.e., hardware), wherein that code produces a tangible result, such as displaying a result on a computer display device.

Regarding independent claims 1 and 31, the language of these claims merely describes non-functional descriptive material. As such, this raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine, which would result in a practical application producing a concrete, useful and tangible result to form the basis of statutory subject matter under 35 USC 101.

One technique for satisfying the requirements of 35 USC 101 is to claim code residing in memory (i.e., hardware), wherein that code produces a tangible result, such as displaying a result on a computer display device.

Dependent claims 2-10, 12-20, 22-30, and 32-35 are dependent upon claims 1, 11, 21, and 31, respectively, and do not add any limitations that would render the claims statutory under 35 USC 101. Therefore, these claims are likewise rejected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allam (U.S. Publication 2004/0139400 A1).

As per independent claims 1 and 21, Allam discloses a method, in a data processing system, for automatically providing bibliographical data associated with copied content including associating citations with content on an electronic page (See Allam, Page 18, paragraph 0284), and, responsive to a copy function performed on the

content, dynamically including the citations within a copy of the content, where the copy is created with its associated citations (See Allam, Page 18, paragraphs 0283-0284).

While Allam does not disclose expressly bibliographical information, Allam does disclose associating citations with content, where the citations may include the original source of the information or content (See Allam, Page 11, paragraph 0107). The well-established meaning of "bibliography", as supported by Applicant's definition of bibliography, that bibliographical information includes relevant data relating to the content (See Instant Specification, Page 3, paragraph 0006) provides reasonable suggestion to the skilled artisan to interpret Allam's associated citations as a form of bibliography. It would have been obvious to one of ordinary skill in the art at the time of the invention to conclude that the citations of Allam provide relevant data and therefore equate to bibliographical information. The motivation for this conclusion would have been that the citation listing the original source of the copied content allows a user to reference the original source of the content in order to view any additional information contained in the original source document that may not have been included in the copied content.

As per independent claim 11, Allam discloses a system including a web browser having displayed thereon a web page that includes content that may be copied by a user (See Allam, Page 4, paragraph 0048), the web browser also including user selection mechanisms for selecting and copying the content, such as cutting and pasting content (See Allam, Page 18, paragraph 0283), a content editor having a display area within which content may be inserted (See Allam, Page 18, paragraphs

0284-0286), the editor also including user selection mechanisms for pasting content that was selected and copied (See Allam, Page 18, paragraph 0285), and information tracking mechanisms associated with both the web browser and the editor that retrieves citations of the content whenever the content is copied and automatically provides the citations for insertion into a bibliographical section within the editor (See Allam, Page 18, paragraph 0284).

While Allam does not disclose expressly bibliographical information, Allam does disclose associating citations with content, where the citations may include the original source of the information or content (See Allam, Page 11, paragraph 0107). The well-established meaning of "bibliography", as supported by Applicant's definition of bibliography, that bibliographical information includes relevant data relating to the content (See Instant Specification, Page 3, paragraph 0006) provides reasonable suggestion to the skilled artisan to interpret Allam's associated citations as a form of bibliography. It would have been obvious to one of ordinary skill in the art at the time of the invention to conclude that the citations of Allam provide relevant data and therefore equate to bibliographical information. The motivation for this conclusion would have been that the citation listing the original source of the copied content allows a user to reference the original source of the content in order to view any additional information contained in the original source document that may not have been included in the copied content.

As per independent claim 31, Allam discloses a method for protecting online content including placing the content within a source file of a web page (See Allam,

Page 4, paragraph 0048), and associating a citation identifier with the content, where the citations identifier is linked to the content such that a copy of the content when the web page is published results in a copying of the citation identifier along with the content (See Allam, Page 12, paragraph 0139).

While Allam does not disclose expressly bibliographical information, Allam does disclose associating citations with content, where the citations may include the original source of the information or content (See Allam, Page 11, paragraph 0107). The well-established meaning of “bibliography”, as supported by Applicant’s definition of bibliography, that bibliographical information includes relevant data relating to the content (See Instant Specification, Page 3, paragraph 0006) provides reasonable suggestion to the skilled artisan to interpret Allam’s associated citations as a form of bibliography. It would have been obvious to one of ordinary skill in the art at the time of the invention to conclude that the citations of Allam provide relevant data and therefore equate to bibliographical information. The motivation for this conclusion would have been that the citation listing the original source of the copied content allows a user to reference the original source of the content in order to view any additional information contained in the original source document that may not have been included in the copied content.

As per dependent claims 2, 13, and 22, Allam discloses the limitations of claims 1, 11, and 21 as described above. Allam also discloses including, responsive to a later paste function performed on the content, pasting the content within a document and inserting the citation data into a citation section within the document (See Allam,

Page 18, paragraphs 0283-0284), and, responsive to a later storage of the copy of the content, saving the copy along with the citation information (See Allam, Page 18, paragraphs 0283-0284).

Dependent claim 12 is rejected on the same basis as claim 1.

As per dependent claims 3, 14, and 23, Allam discloses the limitations of claims 2, 12, and 22 as described above. Allam also discloses requesting user selection of whether the citation information should be inserted within the citation section, and when the user selection is insertion of the information, updating a citation section with the information (See Allam, Page 18, paragraph 0284).

As per dependent claims 4, 15, and 24, Allam discloses the limitations of claims 3, 14, and 23 as described above. Allam also discloses tagging the citation information with an identifier and displaying a copy of the identifier with the content, whereby the link between the citation information and the content is indicated (See Allam, Page 12, paragraph 0139, Page 11, paragraph 0107, and Figure 15).

As per dependent claims 5, 16, and 25, Allam discloses the limitations of claims 2, 13, and 22 as described above. Allam also discloses requesting user selection whether the citation information is to be edited before insertion within the citation section (See Allam, Page 18, paragraph 0284-0285).

As per dependent claims 6, 17, 26, and 34, Allam discloses the limitations of claims 5, 14, 25, and 31 as described above. Allam also discloses enabling the user to delete portions of the bibliographical information, where when one portion of the citation

information is designed for non-deletion, disabling a delete option for that one portion (See Allam, Page 19, paragraphs 0307 and 0311).

As per dependent claims 7 and 27, Allam discloses the limitations of claims 6 and 26 as described above. Allam also discloses that deletion of the one portion also deletes the content from the document (See Allam, Page 19, paragraph 0310).

As per dependent claims 8, 18, 28, and 33, Allam discloses the limitations of claims 1, 12, 21, and 31 as described above. Allam also discloses generating the content utilizing metadata and associating the citation information as meta tags within the metadata (See Allam, Page 9, paragraph 0095).

As per dependent claims 9, 19, and 29, Allam discloses the limitations of claims 1, 12, and 21 as described above. Allam also discloses that the citation information includes source of content (See Allam, Page 18, paragraph 0284).

As per dependent claims 10, 20, 30, and 32, Allam discloses the limitations of claims 1, 12, 21, and 31 as described above. Allam also discloses generating the content utilizing metadata and respectively associating a beginning and an ending comment before and after the content, where the beginning comment introduces and provides the bibliographical information for the content sequentially following in the source code and the ending comment terminates the section of overall content to which the citation information belongs (See Allam, Page 12, paragraph 0139).

As per dependent claim 35, Allam discloses the limitations of claim 31 as described above. Allam also discloses including within the citation identifier the source of the original document, such as a URL. Since it is well known in the art to track a

source of a document by identifying an IP address of the sending computer, it would have been obvious to one of ordinary skill in the art at the time of the invention to conclude that a tracking mechanism, such as the determination of an IP address of the source computer, may be enabled to determine the identification of computer upon which the source document originated for the benefit of providing monetary compensation to the content owner for use of copied content.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Levy (U.S. Publication 2004/0243634 A1) discloses methods to provide copyright notification and sell metadata.
- Thomason (U.S. Publication 2003/0002086 A1) discloses a system and method for capture and utilization of content and source information.
- Zee (U.S. Publication 2003/0065642 A1) discloses an assured archival and retrieval system for digital intellectual property.
- Jones (U.S. Patent 6,493,731 B1) discloses a document management system for recording and viewing the history of document use.
- Uzuner discloses content and expression-based copy recognition for intellectual property protection.

- Kobayashi discloses information retrieval on the Web.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER